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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,694	01/18/2002	Michael E. Lester	33552	1533
116	7590	09/07/2004	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			KIM, PAUL D	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/051,694

Applicant(s)

LESTER ET AL.

Examiner

Paul D Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/18/02</u> .                                                             | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This office action is a restriction requirement filed on 6/28/2004.

#### ***Response to the Restriction Requirement***

1. Applicant's election without traverse of Group II, claims 32-41, in the reply filed on 6/28/2004 is acknowledged.
2. The non-elect claims are cancelled filed on 6/28/2004.

#### ***Specification***

3. The abstract of the disclosure is objected to because the abstract does not sufficiently describe the claimed invention. Correction is required. See MPEP § 608.01(b).
4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: --A JACKET ASSEMBLY FOR A CABLE--.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 32, 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Ueda (JP-09022625 A).

Ueda teaches a jacket assembly for a cable comprising: an elongated jacket (105) comprising a first open end and a second open end as shown in Fig. 1 (a); a leader extending (101) within the jacket from the first open end and the second open end as shown in Fig. 1 (b); a first end of the leader for attachment to a cable (103); and a second end of the leader for pulling the leader out of the elongated jacket while the first end of the leader pulls the cable into the elongated jacket as shown in Fig. 1 (c) (see also abstract).

As per claim 34 the elongated jacket is a flattened tube as shown in Fig. 1 (a).

As per claim 35 the leader is non-woven fibers as shown in Fig. 1 (a).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 33 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda.

As per claim 37 Ueda teaches all of the limitations as set forth above except a material of the leader (as per claims 33 and 37) or jacket (as per claims 36, 39 and 40 for vinyl) that narrows as the leader is elongated by a pulling force. Ueda teaches the

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leader as a conductor, but does not specified what material is used. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to apply the material as recited in the claimed invention because Applicant has not disclosed that the material as recited in the claimed invention provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with Ueda because the leader material as recited in the claimed invention would perform equally well such as pulling the cable out of the jacket and the jacket material as recited in the claimed invention would perform equally well such as protecting tube for the cable in Ueda. Therefore, it would have been an obvious matter of design choice to modify the material of Ueda to obtain the invention as specified in claims 33 and 36.

As per claim 38 dimensions of the leader as a continuous strip is approximately the same as dimensions of the cable as shown in Fig. 1 (b) and (c).

9. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda in view of Maroschak (US PAT. 3,870,774).

Ueda teaches all of the limitation as set forth above except forming the jacket to cut off a desired length. Maroschak teaches a corrugated plastic tube, which is conventionally formed in continuous lengths, it is generally shipped to the consumer either in rolls of a predetermined number of linear feet or in bundles of cut lengths of tubes containing a predetermined linear footage as shown in Fig. 2 (see also col. 1, lines 7-50). Therefore, it would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to modify a jacket of Ueda by the jacket to cut off a desired length as taught by Maroschak in order to improve to cut off the tube at the desired end or length.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D Kim whose telephone number is 703-308-8356. The examiner can normally be reached on Tuesday-Friday between 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Paul D Kim  
Examiner  
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